

### **REMARKS**

This Amendment is filed in response to the Official Action mailed August 7, 2007. In this Amendment, claims 33 and 52 are amended, claim 47 is canceled, claims 62-64 have been added, and claims 34, 51 and 53 are unchanged. Following entry of this amendment, claims 33, 34, 51-53 and 62-64 shall be pending.

#### **I. REJECTIONS UNDER 35 U.S.C. SECTION 102**

Claims 33, 47 and 51 and 53 are rejected under 35 U.S.C. Section 102(e) as being anticipated by U.S. Patent No. 5,941,869 *Patterson, et al. (The Patterson, et al. Patent)*. For at least the reasons set forth below, it is submitted that this rejection should be withdrawn and the pending claims allowed.

Turning to independent claim 33, this claim has been amended to recite that an embolus removal apparatus is disposed on the inner tube.

It has been further amended to recite that the outer tube is axially retractable to remove the constraint on the embolus removal apparatus such that the embolus removal apparatus automatically expands from said collapsed configuration to a deployed configuration upon said axial retraction of said outer tube without requiring axial movement or rotation of the guidewire.

It has been yet further amended to recite that said embolus removal apparatus comprises a plurality of resilient members having proximal ends fixed to said inner tube and distal ends freely slidable over said inner tube and mid-portions that extend laterally away from the catheter body when distal ends slide over said inner tube as said embolus removal apparatus achieves its deployed configuration.

Support for these amendments may be found at least at Figures 19A and 19B and paragraph [0188] of the present application (published version).

For at least three reasons, *The Patterson, et al. Patent* cannot be properly relied upon as anticipating the invention as recited in claim 33. First, there is no embolus removal apparatus disposed on an inner tube in the *Patterson, et al. Patent* as presently recited in claim 33. Referring to Figure 7 of the *Patterson, et al. Patent*, the Examiner

has asserted inner catheter shaft 124 as corresponding to the recited inner tube and the cutting head 120 as corresponding to the recited embolus removal apparatus. As can be seen in Figure 7, the cutting head 120, however, is NOT disposed on the inner catheter shaft 124 in the *Patterson, et al.* device. The cutting head 120 is disposed on the inner actuating member 126 which extends past the distal end of the inner catheter shaft 124.

Second, the *Patterson, et al. Patent* does not show an embolus removal apparatus that automatically expands from a collapsed configuration to a deployed configuration upon axial retraction of an outer tube as recited in claim 33. Referring to Figure 7, the Examiner asserts that the cutting head 120 corresponds to the embolus removal apparatus and, referring to Figure 1, the Examiner asserts that the catheter 60 corresponds to the outer tube. However, even if such correspondence could be properly maintained, the axial retraction of the catheter 60 does NOT result in automatic expansion of the cutting head 120. Instead, the cutting head expands only through independent axial movement by a user of the inner actuating member 126 relative to the inner catheter shaft 124 after the catheter 60 has been removed. See Column 16, lines 52-59 of the *Patterson, et al. Patent*. Movement of the catheter 60 is essentially irrelevant in affecting expansion of the cutting head 120.

Third, the *Patterson, et al. Patent* fails to disclose an embolus removal apparatus that comprises a plurality of resilient members having proximal ends fixed to said inner tube and distal ends freely slidable over said inner tube and mid-portions that extend laterally away from the catheter body when distal ends slide over said inner tube as said embolus removal apparatus achieves its deployed configuration. As stated above, the examiner has asserted that the cutting head 120 corresponds to the embolus removal apparatus and that inner catheter shaft 124 corresponds to the inner tube. Although the proximal ends of the cutting head 120 are fixed to the inner catheter shaft 124 in the *Patterson, et al.* device, the distal ends of the cutting head 120 are NOT. The distal ends of the cutting head 120 are instead connected to the inner actuating member 126, which is entirely separate from the inner catheter shaft 124. Therefore, the distal ends of the cutting head 120 CANNOT freely slide over the inner catheter shaft 124 as

claimed. They can only slide towards the inner catheter shaft 124, which is entirely different and counter to claim 33.

For at least these three reasons, *The Patterson, et al. Patent* fails to anticipate claim 33. Accordingly, the rejection is improper and should be withdrawn.

Claims 51 and 53 depend from claim 33 and thus fail to be anticipated for at least the same reasons set forth above. It is noted, however, that these claims further limit the claimed invention and thus are separately patentable over the cited prior art.

As to claim 47, this claim has been canceled solely in an effort to expedite prosecution of this application.

As to new claims 62-64, these claims further limit the claimed invention and are thus separately patentable over the cited prior art.

## **II. REJECTIONS UNDER 35 U.S.C. SECTION 103**

Claim 52 is rejected under 35 U.S.C. Section 103(a) as being unpatentable over U.S. Patent No. 5,941,869 to *Patterson, et al.* (*The Patterson, et al. Patent*) in view of U.S. Patent No. 5,167,239 to *Cohen et al.* (*The Cohen et al. Patent*). Claim 52 depends from claim 33 and therefore for at least the above reasons presented for claim 33 is also novel and unobvious over the *Patterson, et al. Patent*. Moreover, the undersigned can find no disclosure in *The Cohen et al. Patent* that makes up for the deficiencies of *The Patterson, et al. Patent* as it relates to claim 52. Therefore, for at least these reasons it is submitted that the Section 103 rejection should be withdrawn.

## **III. DOUBLE PATENTING**

Claims 33, 34, 47 and 51-53 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 11, 26, 28 and 89 of U.S. Patent No. 6,685,722. A terminal disclaimer is provided with this Amendment. Therefore, it is requested that the double patenting rejection be withdrawn.

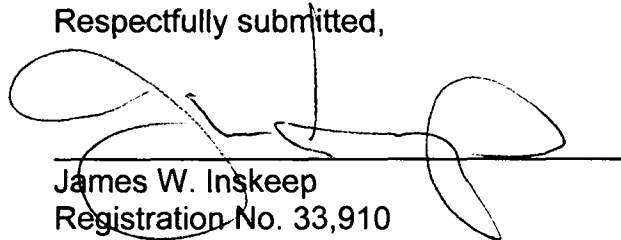
**CONCLUSION**

In view of the foregoing, it is submitted that pending claims 33, 34, 51-53 and 62-64 are now in condition for allowance. Hence an indication of allowability is hereby requested.

If for any reason direct communication with Applicants' attorney would serve to advance prosecution of this case to finality, the Examiner is cordially urged to call the undersigned attorney at the below listed telephone number.

The Commissioner is authorized to charge any additional fee which may be required in connection with this Amendment to deposit account No. 50-2809.

Respectfully submitted,



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